

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of	:	Attorney Docket No. 2008_0518
Burrrhus LANG et al.	:	Confirmation No. 5973
Serial No. 10/030,519	:	Group Art Unit 3766
Filed June 5, 2002	:	Examiner Mark Bockelman
MEDICAL ELECTRODE	:	Mail Stop: AMENDMENT

RESPONSE TO OFFICE COMMUNICATION

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

On February 4, 2010 the Office issued a communication alleging that Applicants' response filed October 7, 2009 was not fully responsive to the prior Office Action, the prior Office Action being dated July 7, 2009. This position by the Examiner is respectfully traversed as being incorrect as a matter of law and fact. The requirement made by the Examiner is respectfully requested to be withdrawn.

Thus, it is submitted that the response filed October 7, 2009 fully responded to all of the issues that were raised by the Examiner. The following may further help to clarify the issue raised by the Examiner.

The Examiner alleges that Applicants' arguments do not particularly point out how the new claims overcome the art "when read in light applicant's specification. Applicant claims that the current-equalizing conductor surrounds the contactable surface, however a brief review of applicant specification only shows the current-equalizing member to partially surround the contactable surface. The examiner is not sure how to interpret this limitation when read in light of applicant's specification since it is not apparent as to how it is supported by applicant's original disclosure." The Examiner then refers to rule 111.

37 CFR § 1.111 requires that "the applicant or patent owner must clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art

disclosed by the references cited or the objections made. The applicant or patent owner must also show how the amendments avoid such references or objections.”

Turning to the response filed October 7, 2009, it may be seen that a new set of claims was presented, generally corresponding to the prior claims, but redrafted and renumbered as new claims 37-56. These claims included independent claims 37, 53 and 56. Each of these independent claims makes reference to a medical electrode that comprises a carrier, at least one electrically contactable conductor surface arranged on the carrier and at least one current-equalizing conductor surface arranged on the carrier at a spacing from the at least one electrically contactable conductor surface, so as to be electrically separated from the at least one electrically contactable conductor surface and so as to surround the at least one electrically contactable conductor surface on the carrier.

As discussed on page 7 of the response, the first page of the remarks, the word “surrounding” was chosen as the language that corresponds directly to that used in the specification as originally filed. Quoting from the remarks on that page “it is understood quite clearly from the disclosure, and the embodiments that are illustrated, that having the current-equalizing conductor surface surround or enclose the electrically contactable conductor surface does not mean that it is entirely or completely surrounded.” Examples are thus made reference to in the drawing figures. Thus it is clear from Applicants’ remarks that Applicants’ position is that by claiming that the current-equalizing member surrounds the contactable surface, it does not mean that it entirely or completely surrounds the contactable surface. In other words, the word ‘surround’ does not necessarily mean ‘completely surround,’ or ‘entirely’ or ‘wholly’ surround, in the context of Applicants’ patent application.

The Examiner’s attention is further directed to the original specification on page 2, lines 11-13, and page 5, lines 12-22.

Thus, regarding the point raised by the Examiner in the communication, the original specification in fact uses the term surround, the same term that is used in the claims. This is consistent with embodiment illustrated as discussed above and as discussed in the Amendment filed October 7, 2009. The Examiner may disagree with this position, but it is submitted that this position is quite reasonable and rational and clear from the content of the original specification and the response filed October 7, 2009.

Nor was the response filed October 7, 2009 deficient in any legal sense with respect to responding to the issues that were raised by the Examiner. The Examiner's argument is that the Examiner is not sure how to interpret the limitation. However, this does not mean that Applicants did not respond to all of the issues that were raised by the Examiner. Beginning at the bottom of page 8 of the response filed October 7, 2009, Applicants go into great detail regarding Applicants' position regarding the Canadian patent to Frize and the U.S. patent to King. Particular distinctions with respect to each of the independent claims, at least, are pointed out with respect to both the references to Frize and King in the discussion that continues to page 13 of the response. Thus, Applicants' arguments particularly pointed out how the new claims overcome the prior art.

Further, this is in fact the case even when read in light of Applicants' specification in accordance with the point that was raised by the Examiner. Applicants were not arguing that the at least one current-equalizing connector surface wholly or completely surrounds the at least one electrically contactable conductor surface as a distinction over the prior art. Rather, Applicants were arguing other distinctions.

Thus, it may be seen that the response that was filed was fully responsive to the issues raised by the Examiner in that Applicants particularly pointed out specific distinctions in each of the independent claims over each of the references that were cited by the Examiner. Thus, the response was not non-responsive.

Further, Applicants particularly pointed out their position regarding the claim language that was used and that raises an issue by the Examiner in the communication. It is respectfully submitted and believed that this is a correct usage of the language based upon Applicants' original specification and disclosure as a whole. The Examiner may disagree with this, and may recommend different language, but this does not render Applicants' position somehow non-responsive.

Accordingly, withdrawal of the notice is requested.

Respectfully submitted,

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